

REMARKS

Claim Rejections – 35 U.S.C. §112

The Office Action rejected claims 10 and 33 as being dependent on cancelled claims, and also rejected claim 27 for lacking proper antecedent basis. Applicant thanks Examiner Torres Velasquez for suggesting the appropriate corrections for placing claims 10, 27 and 33 in order. Thus, applicant has amended claims 10 and 33 to be dependent on pending claims, and has amended claim 27 to provide for proper antecedent basis as suggested by the Examiner. No new matter was added.

Claim Rejections – 35 U.S.C. §103

The Office Action relied on (1) Smith, et al. (U.S. 5, 447, 462) (“Smith”) and (2) Battreall (U.S. 5, 234,523) (“Battreall”) in rejecting all pending claims under 35 U.S.C. §103(a). In particular, the Office Action rejected claims 1-7, 10-12, 27, and 33-34 as being unpatentable over Smith in view of Battreall. Applicant respectfully disagrees with the rejections.

Enclosed herewith is a declaration under 37 C.F.R. §1.132 executed by the inventor. The declaration explains that different physical or chemical forms of adhesives should not be presumed to be interchangeable. Indeed, the thickness, structure and type of adhesive has to be some basic considerations necessary for evaluating the claims from the perspective of one having ordinary skill in the art. The declaration further attests to the existence of unexpected results.

Smith and Battreall individually or in combination are insufficient to maintain the rejection of independent claims 1 and 27 under 35 U.S.C. §103(a) because they do not, individually or in combination, disclose all of the limitations of claims 1 and 27 (see, e.g., response of July 21, 2004, September 26, 2005 and supplemental response of September 29, 2005). The Office Action again concedes that Smith does not teach the use of polyurethane. Smith discloses (i) the use of webs instead of films, and (ii) does not even suggest the use of ester-based polyurethane. Indeed, Smith’s failure to teach or suggest the use of ester-based polyurethane as an adhesive is sufficient to make it unsuitable for basing a rejection thereon.

Battreall does not disclose the claimed range of ester-based polyurethanes or a relevant range thereof in view of the teaching of Haigh (U.S. 3,657,060) (“Haigh”). Haigh was cited in the prior Office Action and disclosed a range of polyester based polyurethane at “about 5 to 12 mils thick,” (Haigh, Col. 2, Lines 50-54), with optimum thickness “at a thickness of 10 mils,” (Haigh, Col. 2, Lines 59-60).

Applicant’s argument is supported by at least (i) cited art in the record, for instance,

Haigh, which teaches that (a) not all adhesives are the same, and (b) the preferred thickness for ester based polyurethane film is about 10 mils; (ii) the attached declaration of Mr. Eric Aerts, which also is in agreement with Haigh as to adhesive properties being different while further confirming the use of thinner sheets of polyurethane than those considered practical by Haigh; and (iii) the extensive examination to date that has failed to identify even a suggestion for making the products described in claims 1 and 27. Applicant notes that even if the ester based polyurethane adhesive were considered to be a known component, the subject matter of claims 1 and 27 is not made the same way due to the thinner adhesive, and, thus, leads to a different result than that described in Haigh. Therefore, the subject matter of claim 1 is unexpected and non-obvious. Not surprisingly, the Office Action has not been able to provide any factual basis to back up its presumption of obviousness. (See, for instance, Office Action, Page 4, Paragraph 2). Thus, the presumption is in violation of the directive of 35 U. S. C. § 103(a) that the evaluation be "at the time the invention was made" (rather than based only on hindsight today). Even if it is to be assumed that a separate showing of criticality is required to overcome this clearly erroneous presumption, Haigh's disclosure and/or the declaration provides the required showing. Therefore, the rejection of independent claims 1 and 27 must be withdrawn.

Applicant's prior responses have already established that the defects (for instance those described in the above remarks) in the combination of Battreall and Smith are not cured by other references cited by the Office Action. Therefore, all of the claims dependent on the patentable independent claims are allowable axiomatically. It is respectfully submitted that the present application is in condition for allowance because all of the rejections have been overcome. Favorable disposition is respectfully requested.

Although no fees are estimated to be due with this response, please charge any required fees to Jones Day Deposit Account No. 50-3013. Please do not hesitate in calling the undersigned, should there be any need for clarifications.

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Respectfully submitted,



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